



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,535	11/16/1999	TAMAKI KOBAYASHI	35.C14023	3083

5514 7590 01/13/2003

FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

[REDACTED] EXAMINER

PATEL, ASHOK

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2879

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/440,535	KOBAYASHI ET AL.	
	Examiner Ashok Patel	Art Unit 2879	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 18 November 0202.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-5, 10-22 and 32-44 is/are pending in the application.

4a) Of the above claim(s) 37-39, (41-44)/(37-39) and 45-61 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5, 10-22, 32-35, 41-44)/(32-35) is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### **Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### **Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____.
--	---

1. The Examiner admits that there was an inadvertent error relating to U.S. Patent 4,954,744 listed in the past PTOL-1449. The Examiner considers U.S. Patent 4,954,744. Enclosed please find corrected version of the PTOL-1449.

2. In view of applicant's attempt of amending, and broadening scope of, independent claim 32, its indicated allowability is withdrawn. Applicant is reminded the Examiner did not reject claim 32 under 35 U.S.C. 112, in last office action. It was claims 33-35 and (41-44) / (33-35) that were rejected under 35 U.S.C. 112, second paragraph rejection, not claim 32. Claim 32 was presented properly with respect to 35 U.S.C. 112, second paragraph. In view of the Examiner's comments in paragraph 1 of the last office action (paper no. 13), the Examiner reinstates previous restriction requirement in this office action (since claim 32 is now found rejectable over prior art). Accordingly claims 37-40 and (41-44) / (37-40) are withdrawn again from consideration. Newly added claims 45-61 are also withdrawn from consideration since they are also directed to the non-elected species invention. As mentioned in paper no. 11, paragraph 1, the restriction requirement is deemed proper and is therefore made FINAL.

Art Unit: 2879

3. In the last office action (paper no. 13), the Examiner allowed claims 1-5 and 10-22 on the cover sheet of the last office action. This was an inadvertent error. The Examiner realized that the last office action should have repeated rejection of claims 1-5 and 10-22. Instead, the repeating of rejection of claims 1-5 and 10-22 was omitted. This office action however corrects that error. Since the Error was on part of the Examiner, the Examiner withdraws finality of previous rejection.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2879

5. Claims 1, 2, (10-22)/(1,2), 32, 33, and (41-44)/(32, 33) are rejected under 35 U.S.C. 102(a or b or e, depending upon effective filing date) as being anticipated by Nishimura et al, EP '892, of record).

Nishimura et al disclose applicant's claimed image forming device (Figures 1, 5, 8-12, 16; page 3, lines 21-26; page 5, lines 39-43) including an electron source (as shown in Figure 1B), the electron source further including: a sodium containing substrate (1), an  $\text{SiO}_2$  first layer (2), a second layer containing electron conductive oxide (4), and a pair of electrodes (2, 3) formed on the substrate.

Consequently, Nishimura et al anticipate applicant's claims 1, 2, (10-22)/(1,2), 32, 33, and (41-44)/(32, 33).

6. Claims 1, 2, (10-22)/(1,2), 32, 33, and (41-44)/(32, 33) are rejected under 35 U.S.C. 102 (a or b or e -depending upon effective filing date-) as being clearly anticipated by Miyamoto et al (EP '931, of record).

In Figures 21b, 9, 9, 10, 16 etc., Miyamoto et al disclose applicant's claimed image forming device including: an electron source includes a sodium containing substrate (1), an  $\text{SiO}_2$  layer (6) and an electron conductive oxide layer (2, 3) or layer 4).

Art Unit: 2879

Consequently, Miyamoto et al anticipate applicant's claims 1, 2, (10-22)/(1,2), 32, 33, and (41-44)/(32, 33).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3-5, (10-19)/3-5), 34-36 and (41-44)/(34-36) are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura et al (or Miyamoto et al, applied individually), as above.

Although Nishimura et al do not disclose the second layer including SiO<sub>2</sub> or the first layer of the substrate (the substrate structure) including P or B or Ge, providing such elements would have been obvious to one of ordinary skill in the art for optimizing properties of the substrate structure depending upon

Art Unit: 2879

the application of the substrate structure such as an electron source or a simple base support structure or a spacer etc..

Alternatively, depending upon certain application of the substrate structure, e.g. as a spacer or as a simple base support, providing including P or B or Ge, is not required or would have been a matter of obvious design choice since inclusion of such elements is unnecessary.

In view of absence of appropriate English translation of certified copies, the Examiner considers applicant's U.S. filing date as an effective filing date.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok Patel whose telephone number is 703-305-4934. The examiner can normally be reached on Monday-Thursday.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.

  
Ashok Patel  
Primary Examiner  
Art Unit 2879